

REMARKS

As an initial matter, Applicant sincerely thanks the Examiner for the courtesies extended to Applicant's representatives during the interview conducted at the U.S. Patent and Trademark Office (PTO) on March 9, 2004. In accordance with M.P.E.P. § 713.04, the amendments and remarks set forth herein address the issues that were discussed during that interview.

As discussed during the interview, Applicant requests that the finality of the Office Action dated December 16, 2003 be withdrawn since at least claim 98 was subject to new rejections based on references that were not submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. 1.97(c). More specifically, in the previous Office Action dated June 30, 2003, claim 98 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,225,253 to Fraleigh. Claim 98 was not subject to any other grounds of rejection. In the September 29, 2003 Amendment responsive to the Office Action dated June 30, 2003, Applicant made no substantive amendment to claim 98. Rather, claim 98 was amended merely to correct a typographical error by changing "application member" to --applicator member--.

In the outstanding Office Action, the Examiner newly rejected claim 98 and some of its dependent claims under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,132,370 to Capezzuto and by U.S. Patent No. 3,266,079 to Schwartzman. Both Capezzuto and Schwartzman were cited by the Examiner in the first Office Action on the merits mailed on June 14, 2002. The new rejections of claim 98 and some of its dependent claims based on Capezzuto and Schwartzman thus make the finality of the Office Action improper under the provisions of M.P.E.P. § 706.07(a), which states

[u]nder present practice, second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

M.P.E.P., 8th ed. (Emphasis added).

For at least this reason, Applicant requests the withdrawal of the finality of the Office Action dated December 16, 2003.

Even if the Examiner refuses to withdraw the finality of the Office Action, Applicant respectfully requests the Examiner to indicate (e.g., by completing the appropriate section of an Advisory Action) that the present amendment would be entered at least for purposes of appeal. As explained below, the amendment reduces the number of issues and does not present any new issues requiring further search and/or consideration.

Applicant thanks the Examiner for indicating in the Office Action dated December 16, 2003, that claims 13 and 80 are allowable and that claims 73, 92, and 167 contain allowable subject matter. As discussed during the interview, by this Amendment, Applicant has canceled independent claims 64, 75, and 160, as well as dependent claims 86-97 and 161-172, without prejudice or disclaimer. Applicant reserves the right to present the subject matter of those canceled claims at a later date. Additionally, Applicant has amended claim 73 to place that claim in independent form, and also has amended claims 65-67, 70, 74, 76, 77, 81, 83, and 84 to make those

claims dependent from claim 73. Accordingly, claims 65-74, 76-79, 81-84 are allowable.¹

In the Office Action, currently pending claims 4-6, 14-28, 36, 37, 44, 46, 47, 50, 51, 57, 58, 82, 83, 100-102, 109-115, 131-133, and 140-146 were withdrawn from consideration as allegedly being directed to nonelected species. Applicant does not necessarily agree with the Examiner's withdrawal of certain claims that Applicant indicated as "reading" on the elected species as set forth in the Amendment After Final filed March 10, 2003 and the Response to Election of Species Requirement filed March 5, 2002. Nonetheless, since all of the withdrawn claims depend from one of independent claims 1, 73, 98, and 129, which are allowable, Applicant requests the rejoinder and allowance of the withdrawn claims.

Claims 64-72, 74-79, 81, 84-91, 93-97, 160, 161, 163-166, and 168 were rejected under 35 U.S.C. § 102(b) based on EP 0872193. Without expressing any view about the propriety or impropriety of that rejection, Applicant has either canceled those claims or changed their dependency so as to obviate the rejection and advance prosecution.

In the Office Action, the Examiner rejected pending independent claims 1, 98, and 129, and various dependent claims, under 35 U.S.C. §102(b) as being anticipated by Capezzuto and/or by Schwartzman, and rejected several other dependent claims under 35 U.S.C. §103(a) as being unpatentable in view of either Capezzuto or Schwartzman alone or in combination with U.S. Patent No. 2,659,919 to McCabe et al.

¹ Claims 82 and 83 were withdrawn from consideration. However, since those claims depend either directly or indirectly from claim 73, Applicant requests that the claims be rejoined and allowed.

(“McCabe”). As explained in more detail below, the rejections based on Capezzuto and Schwartzman should be withdrawn because the Examiner relies on allegedly inherent disclosure found in those references, but the Examiner has not satisfied the burden required by legal precedent and the M.P.E.P. for establishing such inherent disclosure.

Independent claim 1 recites, among other things, an “applicator member including . . . at least one absorbent material capable of being at least partially compressed; and an elastically compressible support supporting the applicator member . . . , the support having a compressibility greater than the compressibility of the applicator member.” Independent claim 98 recites, among other things, an “applicator member including . . . at least one spongy material; and an elastically compressible support supporting the applicator member . . . , the support having a compressibility greater than the compressibility of the applicator member.” Independent claim 129 recites, among other things, an “applicator member comprising an absorbent material and configured to be at least partially compressed; and an elastically compressible support supporting the applicator member . . . , the support having a compressibility greater than the compressibility of the applicator member, wherein the applicator member is configured to release product absorbed by the applicator member in response to compression of the application member.”

Capezzuto is directed to a sealable liquid-dispensing applicator. Referring to Figs. 2 and 3, the Capezzuto reference discloses a squeeze-bottle container 10 with a resilient, absorbent, liquid-permeable membrane 34 and a resilient, abrasion-resistant, liquid-permeable membrane 36.

In the rejection based on Capezzuto, the Examiner equates the resilient, abrasion-resistant, liquid-permeable membrane 36 to the applicator member recited in claims 1, 98, and 129. Also, the Examiner equates the resilient, absorbent, liquid-permeable membrane 34 of Capezzuto to the elastically compressible support recited in claims 1, 98, and 129.

Capezzuto neither discloses nor otherwise suggests that membrane 36 includes either at least one absorbent material (claim 1) or at least one spongy material (claim 98). The cited reference also does not disclose or suggest that membrane 36 comprises an absorbent material (claim 129). For example, with respect to claims 1 and 129, rather than disclosing that the membrane 36 includes any absorbent material, Capezzuto discloses that membrane 34 is absorbent. At col. 1, lines 53-57 and at col. 2, lines 64-66, Capezzuto discloses the membrane 36 as being made of a woven or perforated plastic, fiber or sheet material, or a fabric of artificial or natural fibers, but does **not** disclose that the membrane 36 comprises any absorbent material or any spongy material. Thus, Capezzuto neither discloses nor otherwise suggests an applicator member structure as recited in any of independent claims 1, 98, or 129, and therefore independent claims 1, 98, and 129 are patentably distinguishable from Capezzuto.

Since there is no explicit disclosure in Capezzuto of the membrane 36 comprising any absorbent or spongy material, as discussed during the interview, the Examiner is relying on alleged inherent disclosure in that reference to support the rejections of claims 1, 98, and 129.

Indeed, at page 8 of the Office Action, the Examiner asserts that:

Capezzuto discloses [] a resilient abrasion-resistant liquid-permeable membrane 36 which may be formed of fabrics of artificial or natural fibers To an extent, fabrics of natural or artificial fibers, for example, cotton or polyester, inherently have an absorbency property and are capable of absorbing liquid Therefore, the membrane [36] of Capezzuto is considered as an “absorbent” material as claimed.

Applicant respectfully disagrees with the Examiner’s assertions regarding the alleged disclosure, inherent or otherwise, in Capezzuto. To begin with, Capezzuto neither discloses nor otherwise suggests that the permeable membrane 36 is made of cotton or polyester. The Examiner apparently tries to rely on the Everett et al., Drelich, and Benitez references cited at page 8 of the Office Action to support his assertion that the membrane 36 of Capezzuto is somehow inherently made of cotton or polyester. However, those references cannot be relied on as a substitute for such missing explicit disclosure in Capezzuto. Contrary to the Examiner’s assertion, Capezzuto nowhere discloses, either explicitly or implicitly, that the fibers with which the permeable membrane can be made are necessarily cotton or polyester and the Examiner provides no basis for asserting otherwise. Moreover, Capezzuto does not disclose, implicitly or explicitly, that the membrane 36 includes at least one spongy material, as recited in claim 98. Indeed, the Examiner has not explained what disclosure in Capezzuto he is relying on to support such an assertion.

Instead of finding explicit disclosure in Capezzuto that membrane 36 includes any absorbent or spongy material, as the Examiner has explained at page 8 of the Office Action and during the interview, the Examiner is relying on principles of inherency to support this assertion. Yet in order to rely on inherency as the basis for rejecting the claims, the Examiner must show that “the missing descriptive matter is *necessarily*

present" in the reference. See M.P.E.P. § 2112 (quoting *In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112 (emphasis in original.) Further, "[i]nherency . . . may not be established by probabilities or possibilities" like the various hypothetical examples of natural and artificial fibers for membrane 36 that the Examiner posed during the interview. As explained by Applicant's representatives, and indeed acknowledged by the Examiner, during the interview, there are many natural and artificial fibers that the permeable membrane 36 of Capezzuto could be made from that are neither absorbent nor spongy. Moreover, there is nothing in Capezzuto that would suggest to a skilled artisan that the permeable membrane is **necessarily** made of either cotton or polyester. To the contrary, Capezzuto explicitly describes the membrane 34, and **not** the membrane 36, as "absorbent" and made of cotton. Such explicit disclosure regarding the membrane 34 including such characteristics and the silence as to the membrane 36 including those characteristics would imply to skilled artisans that membrane 36 is neither absorbent nor made of cotton.

Similarly, Capezzuto also does not disclose or otherwise suggest, either explicitly or inherently, that the membrane 34 has a compressibility greater than the membrane 36, as alleged by the Examiner. Indeed, there is nothing in Capezzuto to suggest anything regarding the relative compressibilities of the membrane 34 and the membrane 36, and the Examiner has pointed to nothing in the disclosure of Capezzuto which supports his assertion otherwise. Capezzuto is utterly silent as to any relative compressibility between these membranes, and therefore contains no disclosure

whatsoever that the membrane 34 has a greater compressibility than the membrane 36, as the Examiner asserts in the Office Action.²

Once again, as discussed during the interview, the Examiner relies on alleged inherent disclosure in Capezzuto to support the assertion that the membrane 34 has a greater compressibility than the membrane 36. However, as set forth above, the Examiner has not met the burden required by the M.P.E.P. to support the assertion that the membrane 34 and the membrane 36 **necessarily** have the relative compressibilities recited in claims 1, 98, and 129. Rather, even the hypothetical examples of materials that the Examiner cited during the interview would not satisfy the claimed compressibility relationship. To the extent the Examiner could provide an example of materials that could be selected such that the membrane 34 has a greater compressibility than the membrane 36, such an example amounts only to a mere possibility that the claimed compressibility relationship is met and does not satisfy the burden of establishing inherency. As explained above, a claim rejection relying on alleged inherent disclosure requires the Examiner to show that the membrane 34 and the membrane 36 are **necessarily** made from materials such that the membrane 34 has a greater compressibility than the membrane 36.

² At page 31 of the Amendment filed September 29, 2003, Applicant's statements regarding the lack of disclosure in Capezzuto that membrane 36 is compressible or capable of being at least partially compressed may have unintentionally mischaracterized the disclosure of Capezzuto. Applicant intended to characterize that reference as containing no explicit disclosure regarding the compressibility of membrane 36. Upon further review and consideration of Capezzuto, Applicant acknowledges that the disclosure of membrane 36 as being resilient could possibly concern a membrane that is compressible. Nonetheless, however, Capezzuto fails to disclose or otherwise suggest anything regarding the relative compressibilities of membranes 34 and 36.

Further, inasmuch as Capezzuto teaches that membrane 36 is more abrasion resistant than membrane 34, it is possible that Capezzuto teaches membrane 36 having a compressibility **greater** than the compressibility of membrane 34. For instance, as compared to a member lacking abrasion resistance, a membrane having a relatively highly abrasion resistant property is sometimes better suited for absorbing a friction force without deterioration. To absorb the friction force, such a material may have a relatively high compressibility. In such an example, the membrane 36 would quite possibly have a compressibility **greater** than the membrane 34, which is not disclosed as being abrasion resistant.

Should the Examiner maintain his unsupported assertions that the fibers disclosed by Capezzuto necessarily are cotton or polyester fibers, that the Capezzuto fibers are necessarily absorbent or spongy, or that the membrane 34 of Capezzuto necessarily has a compressibility greater than the compressibility of the membrane 36, Applicant respectfully requests that the Examiner supply a personal affidavit setting forth specific facts within his personal knowledge that support his assertions regarding Capezzuto, in accordance with 37 C.F.R. § 1.104(d)(2) and M.P.E.P. §2144.03.

For at least the above reasons, Applicant respectfully submits that the Examiner has not met the burden required by the M.P.E.P. for establishing the alleged inherent disclosure of Capezzuto relied on by the Examiner to support the rejections of claims 1, 98, and 129 based on that reference. Accordingly, claims 1, 98, and 129 are patentably distinguishable from Capezzuto.

Like the rejections of independent claims 1, 98, and 129 based on Capezzuto, the rejection based on Schwartzman also should be withdrawn because Schwartzman

does not disclose, either explicitly or inherently, either an "applicator member including . . . at least one absorbent material capable of being at least partially compressed; and an elastically compressible support supporting the applicator member . . . , the support having a compressibility greater than the compressibility of the applicator member," as recited in claim 1; an "applicator member including . . . at least one spongy material; and an elastically compressible support supporting the applicator member . . . , the support having a compressibility greater than the compressibility of the applicator member," as recited in claim 98; or an "applicator member comprising an absorbent material and configured to be at least partially compressed; and an elastically compressible support supporting the applicator member . . . , the support having a compressibility greater than the compressibility of the applicator member, wherein the applicator member is configured to release product absorbed by the applicator member in response to compression of the application member," as recited in claim 129.

Referring to Figs. 2 and 3, Schwartzman discloses a container 12 and a dauber assembly 14 adapted to be permanently attached to the container 12. The dauber assembly 14 includes a valve housing 15 and a disc 20. The disc 20 has a lower layer 23 made of a coarse polyurethane foam and an upper layer 21 formed of a nylon knitted brush fabric. In rejecting the claims based on Schwartzman, the Examiner equated the upper layer 21 of disc 20 taught by Schwartzman to Applicant's recited "applicator member" and equated disc 20 to Applicant's recited "support."

Schwartzman fails to disclose or otherwise suggest that the upper layer 21, which the Examiner equates to the claimed "applicator member," either comprises at least one absorbent material (claim 1) or at least one spongy material (claim 98) or

comprises an absorbent material (claim 129). There is no explicit disclosure in Schwartzman that the upper layer 21 is in any way absorbent or made of a spongy material, and the Examiner points to none in the Office Action. The Examiner relies on inherency to support his assertion that the upper layer 21 is absorbent or made of a spongy material. However, the Examiner has failed to satisfy the burden required by the M.P.E.P., as discussed in more detail above, requiring him to show that the upper layer 21 **necessarily** includes either an absorbent material or a spongy material.

Moreover, in a manner similar to Capezzuto, the Schwartzman reference also is completely silent as to any relative compressibilities between the upper layer 21 and the lower layer 23. Again, as discussed during the interview, the Examiner relies on principles of inherency to support his assertion that the lower layer 23 has a compressibility greater than the upper layer 21. However, as is the case with Capezzuto, the Examiner has not satisfied the burden required by the M.P.E.P. to establish such inherent disclosure in Schwartzman. That is, the Examiner has failed to establish that lower layer 23 **necessarily** has a compressibility greater than the upper layer 21. Instead, as discussed during the interview, the Examiner offered **possible** arrangements in which the lower layer 23 **could** have a compressibility greater than the compressibility of the upper layer 21. As explained above, the burden of establishing inherency is not met by such mere possibilities. Indeed, because in Schwartzman, the lower layer 23 could be made of a relatively rigid and coarse foam material, it is not **necessarily** more compressible than the upper layer 21.

For at least these reasons, therefore, the Examiner has failed to establish that Schwartzman inherently discloses the various claimed structural arrangements of the

applicant member and the support set forth in claims 1, 98 129, and the thus the rejection of those claims based on Schwartzman should be withdrawn. Accordingly, claims 1, 98, and 198 are patentably distinguishable from Schwartzman.

As noted above, the Examiner relied on McCabe in combination with either Capezzuto or Schwartzman to reject certain dependent claims. McCabe does not cure the above-noted deficiencies of the Capezzuto and Schwartzman references, and the Examiner has not asserted otherwise in the Office Action. Rather, the Examiner relies on McCabe for its alleged teachings of “a reservoir 12 having a diaphragm portion 14a.”

For at least the reasons explained above, therefore, the various Section 102(b) and 103(a) rejections based on Capezzuto and Schwartzman should be withdrawn.

As mentioned above, withdrawn claims 4-6, 14-28, 36, 37, 44, 46, 47, 50, 51, 57, 58, 82, 83, 87, 100-102, 109-115, 131-133, 140-146, and 162 depend from one of allowable claims 1, 73, 98, 129, and 160. Applicant therefore requests that the withdrawn claims be rejoined and also allowed.

The various dependent claims are allowable for at least the same reasons that the respective independent claim from which each depends is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore also are separately patentable.

The Office Action contains numerous characterizations of the claims and the related art with which Applicant does not necessarily agree. Moreover, and by way of example only, the Examiner makes several conclusory assertions regarding how the related art devices are “capable” of being used, what methods are “inherently” performed using those devices, what is “routine skill in the art,” and what “would have

been obvious to one of ordinary skill in the art," and provides no support for those assertions. Unless expressly noted otherwise, Applicant declines to subscribe to any statement, characterization, conclusion, or assertion set forth in the Office Action.

Applicant respectfully requests the withdrawal of the finality of the Office Action, the withdrawal of the outstanding claim rejections, the rejoinder of the withdrawn claims, and the timely allowance of the pending claims 1-63, 65-74, 76-85, 98-159, and 173-175.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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